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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,371	11/24/2000	Chang-Woong Yoo	P56218	3060

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12/21/2006

EXAMINER

ROCHE, TRENTON J

ART UNIT

PAPER NUMBER

2193

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/718,371

Applicant(s)

YOO, CHANG-WOONG

Examiner

Trenton J. Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 11-22 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☒ Claim(s) 7, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

1. This Office action is responsive to communications filed 16 August 2005 and 16 December 2005.
2. Claims 1-22 are currently pending and have been examined.

### *Response to Arguments*

3. Applicant's arguments, see the remarks, filed 16 August 2005, with respect to claims 1-22 have been fully considered and are persuasive. The rejections under 35 U.S.C. §§ 112, 2<sup>nd</sup> and 103 have been withdrawn.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 09/836,333. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention and recites only nominal differences which would have been obvious to one of ordinary skill in the art at the time of invention.

**Regarding claim 6:**

Copending Application claim 13 discloses:

- in a computer system having a central processing unit, a main memory, a BIOS ROM, and an auxiliary memory for storing BIOS setup information used by a BIOS program stored in the BIOS ROM (“the computer system comprising a central processing unit, a main memory, a basic input-output system read only memory, an auxiliary memory storing therein information set up by the basic input-output system read only memory...” in claim 12)
- and using an operating system program containing product key information (“using the operating system program having the product key” in claim 12)
- writing the product key information into the auxiliary memory when the operating system program is first installed, the method comprising inputting the product key information corresponding to a procedure of installing the operating system program (“initial install of a first program...reading the product key...by a bar code reader, corresponding to an installation process of the operating system program being a first program...storing the product key in a product key storage...” in claim 12. Furthermore, claim 13 states that the product key storage is in an auxiliary memory.)

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- executing a product key information writing program (“activating a product key storage program” in claim 12)
- writing the input product key information into the auxiliary memory (“storing the product key in a product key storage...” in claim 12. Furthermore, claim 13 states that the product key storage is in an auxiliary memory.)

substantially as claimed. Copending Application claim 13 does not explicitly disclose inputting the product key information manually by a user, and instead discloses inputting a product key by a bar code using a bar code reader. While the Examiner notes that scanning a bar code could be interpreted as a manual form of input, Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to manually input a product key into the system disclosed in Copending Application claim 13, as this would enable a user to input a product key if no bar code reader could be found.

Furthermore, the instant claim does not recite the additional steps of initiating a reinstallation of the program on the computer system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the steps of reinstallation from the method recited in the copending claim for the purpose of expediting the method.

**Regarding claim 8:**

Copending Application claim 13 discloses:

- in a computer system having an operating system program containing product key information and comprising a central processing unit, a main memory, an auxiliary memory having the product key information, manually input by a user when the operating system

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program was first installed, stored therein (Note rejection regarding claim 6 above)

- re-inputting the product key information when reinstalling the operating system program (“initiating a reinstallation of the first program on the computer system...inputting the product key into a product key window...” in claim 12.)
- reading out the product key information from the auxiliary memory (“reading the product key from the second data storage unit” in claim 12. Furthermore, the product key storage is in an auxiliary memory, as noted in claim 13. The second data storage unit is interpreted to be the product key storage, which is in the auxiliary memory.)
- checking whether the read-out product key information is matched with product key information of an operating system program that will be reinstalled (“initiating a reinstallation of the first program...comparing the product key read from the product key storage with the product key of the first program” in claim 12)
- if matched, inputting the product key information in a product key information input window displayed on a screen corresponding to an installation procedure for reinstalling the operating system program (“inputting the product key into a product key input window of the first program when the product keys are compared to be identical...continuing to complete the reinstallation of the first program...” in claim 12)

substantially as claimed. While Copending Application claim 13 discloses inputting the product key information when reinstalling the program, Copending Application claim 13 does not explicitly disclose automatically inputting the product key. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically input the product key into the product key input window in the system disclosed in Copending Application claim 13, as this would save the user time and effort of manually inputting the product

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key.

Furthermore, the instant claim does not recite the additional steps of initially storing the product key information prior to installing the remainder of the first program, nor the steps of allowing a user to directly input a product key when the product keys are found to not match. It would have been obvious to one of ordinary skill in the art at the time the invention was made to omit these steps regarding installation and reinstallation from the method recited in the copending claim for the purpose of expediting the method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

6. Claims 1-5 and 11-22 are allowed.
7. Claims 7, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trenton J Roche  
Examiner  
Art Unit 2193

TJR

  
**MENG-AI T. AN**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER